

### **REMARKS/ARGUMENTS**

These remarks are made in response to the Office Action of March 26, 2009 (Office Action). As this response is timely filed within the 3-month shortened statutory period, no fee is believed due. However, the Examiner is expressly authorized to charge any deficiencies to Deposit Account No. 14-1437.

### **Claim Rejections-35 U.S.C. § 101**

Claims 23-27 and 33-38 were rejected under 35 U.S.C. § 101 as it was asserted that the claimed invention is directed to non-statutory subject matter. More specifically, it was asserted that Claims 23-27 recite a process that is neither tied to another statutory class (such as an apparatus) nor transforms underlying subject matter to a different state; Claims 33-38, directed to an apparatus, lack any structure and are directed to software *per se*.

Applicants submit that a person of ordinary skill in the art would readily appreciate that practicable embodiments of the claimed invention would be conducted with the aid of a computing machine, such as a server. Such computing machines are commonly understood to have memory. Further, the operations recited in the claims clearly change the state of the underlying data since the cache, register, or other memory on which the data is stored must be transformed to have a different magnetic polarity, electrical charge, or the like depending on the technology that is used. These are real physical changes. Further, memory is a real physical article. As such, Applicants submit that the method claims perform a transformation under the “machine or transformation” test and thus qualify as patent-eligible subject matter.

In order to facilitate prosecution of the instant application, Claims 23-27 and 33-38 have been modified to clearly recite a computer-implemented method and system, respectively.

Regarding Claims 33-38, it is noted that at least means for inputting commerce data involves hardware and thus the claims are not software *per se*.

**Claim Rejections-35 U.S.C. § 112**

Claims 33-38 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Although Applicants disagree with the rejections, Applicants have amended the claims in an effort to even more clearly define the present invention and to facilitate prosecution of the instant application.

**Claim Rejections-35 U.S.C. § 102**

Claims 22-38 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Published Patent Application 2004/0162741 to Flaxer, *et al.* (hereinafter Flaxer).

Applicants believe that any rejections are moot because Applicants' invention predates the earliest effective date, February 7, 2003, of Flaxer.

**Applicants' Invention Predates Flaxer**

Applicants' invention predates the February 7, 2003 effective date of Flaxer. Applicants conceived of their invention at least as early as July 12, 2002, and actively pursued its reduction to practice from a date prior to the effective date of Flaxer. In support of this assertion, Applicants submit the Declarations attached hereto. The Declarations provide sworn testimony of Applicants' conception and continuing diligence from a time prior to the effective date of Flaxer to the filing of the instant Application on November 17, 2003.

Along with the Declarations, Applicants also submit herewith a copy of Confidential Invention Disclosure No. BOC8-2002-0086 (Exhibit "A"), entitled "A mechanism for automatically synchronizing items between retailers and suppliers based on a model-driven strategy" (hereinafter Invention Disclosure). The Invention Disclosure

was submitted on July 12, 2002, by Applicants to an intellectual property (IP) professional employed by the assignee of Applicants' invention, International Business Machines Corporation (hereinafter IBM). The Invention Disclosure was insubstantially modified by Applicant on August 2, 2002. As affirmed in the Declarations, the modifications did not in any way change the actual invention disclosure. As explained below, IBM internal procedures preclude any modification to the description of the invention subsequent to submission to an IBM professional.

The Invention Disclosure explicitly describes Applicants' invention. The written description provided in the Invention Disclosure is clear evidence of Applicants' conception of the claimed subject matter at least as early as July 12, 2002.

The Invention Disclosure is an IBM confidential disclosure form. It is a standardized document that, according to established IBM procedures, is used by IBM inventors to document the conception of an invention. Strictly-followed internal procedures established by IBM govern the use of all such confidential disclosure forms. One aspect of IBM's established procedures governing the use of such confidential disclosure forms is that no substantive modifications can be made to a confidential disclosure after it has been submitted to an IBM Attorney/IP Professional.

The written description, drawings, and each of the claims of the Application were prepared based upon the Applicant's attached Disclosure. Moreover, according to IBM's established procedures governing the use of such disclosures, the Applicants reviewed the Application prior to its submission to the U.S. Patent and Trademark Office in order to ensure that the claims and written description contained therein were fully supported by the Invention Disclosure.

Applicants exercised due diligence from prior to the effective date of Flaxer to the date that the instant Application was filed. As expressly affirmed in the Declarations, Applicants from at least July 12, 2002, through the filing of the Application, worked diligently toward a constructive reduction to practice of the invention, first with IBM's

own in-house IP professionals, and then with outside counsel retained by IBM to prepare and file the Application.

In further support of Applicants' assertion of diligence, Applicants also submit herewith the following documents:

- (1) Exhibit "B" – Disclosure Evaluation dated August 19, 2002;
- (2) Exhibit "C" – a letter from IBM instructing outside counsel to prepare the Application based on the Invention Disclosure, dated March 13, 2003;
- (3) Exhibit "D" – a letter from outside counsel confirming receipt of instructions, dated March 14, 2003;
- (4) Exhibit "E" – an email letter from outside counsel enclosing the initial draft Application for inventors' review, dated October 14, 2003;
- (5) Exhibit "F" – an email letter from Inventor Yiming Ye approving the draft Application, dated November 3, 2003;
- (6) Exhibit "G" – an email letter from outside counsel enclosing the final draft Application together with Declaration and Assignment for the inventors to sign, dated November 5, 2003;
- (7) Exhibit "H" – an email letter from outside counsel informing IBM the filing of the Application, dated November 17, 2003.

Outside counsel prepared the Application consistent with long-established professional practices, according to which cases are prepared on a first-in, first-out basis unless a particular application is associated with a bar date; those applications associated with bar dates are granted priority within the work queue. Outside counsel followed this professionally-accepted practice in preparing the Application in this case. Applicants diligently cooperated with outside counsel to prepare the Application, promptly responding to requests for review of the Application and requests for providing documents.

Accordingly, in view of the sworn testimony provided and the supporting documents included herewith, Applicants respectfully submit that Applicants' invention

predate the effective date of Flaxer. Applicants therefore respectfully request withdrawal of Flaxer as a reference and further submit that all claims are now allowable over the cited prior art. Moreover, even if Flaxer was deemed a proper reference for the present application, the claims still define over Flaxer asserted in the Office Action, as shown below.

**The Claims Define Over The Prior Art**

Flaxer concerns a system and method for supporting Product Lifecycle Management, which manages and supports complex tasks throughout a products lifecycle including phases such as product conception (marketing and business analysis), product development (engineering and other product development tasks), production and distribution (enterprise resource planning and supply chain management), and customer service and support (customer relationship management). However, Flaxer does not concern conducting an electronic commerce transaction involving two or more discrete business entities and/or business applications as does the present invention. It is noted that in Flaxer all the phases involved are within one business entity.

Flaxer also does not disclose the concept of an adaptive document, which is a semi-autonomous software unit that encapsulates business data and can exhibit variable behavior based upon different processing states. Flaxer further does not disclose the concept of a data adaptor for converting data from one format to another format in order to reconcile data formats so that data can be exchanged between different applications, and a transport adapter for translating messages between messaging protocols used by different applications. Using these common application independent software building blocks, such as the adaptive documents and the adaptors, the present invention can achieve business process integration involving two or more discrete business entities and/or business applications.

Accordingly, Flaxer fails to disclose or suggest each and every element of Claims 23, 28, and 33. Applicants therefore respectfully submit that Claims 23, 28, and 33

define over the prior art. Furthermore, as each of Claims 26-27, 31-32, and 34-38 depends from Claims 23, 28, or 33 while reciting additional features, Applicants further respectfully submit that Claims 26-27, 31-32, and 34-38 likewise define over the prior art.

Applicants thus respectfully request that the claim rejections under 35 U.S.C. § 102 be withdrawn.

### **CONCLUSION**

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

NOVAK DRUCE + QUIGG LLP

Date: **June 23, 2009**

/Gregory A. Nelson/

Gregory A. Nelson, Registration No. 30,577

Yonghong Chen, Registration No. 56,150

Customer No. 40987

525 Okeechobee Blvd., 15<sup>th</sup> Floor

West Palm Beach, FL 33401

Telephone: (561) 838-5229